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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/010,555	01/28/93	SOLAZZI	M CHEMPLEX-3

EXAMINER
~~GAND, M~~

18M1/0107

ART UNIT	PAPER NUMBER
1809	9

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DATE MAILED: 01/07/94

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☑ This application has been examined ☑ Responsive to communication filed on 10/29/93 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), — days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☐ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice of Draftsman's Patent Drawing Review, PTO-948.
3. ☐ Notice of Art Cited by Applicant, PTO-1449.
4. ☐ Notice of Informal Patent Application, PTO-152.
5. ☐ Information on How to Effect Drawing Changes, PTO-1474.
6. ☐ _____.

Part II SUMMARY OF ACTION

1. ☑ Claims 21-24 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. ☑ Claims 1-20 have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☑ Claims 21-24 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____. has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

Part III DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
>
> Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 86 S.Ct. 684, 15 L.Ed. 2nd 545 (1966), 148 USPQ 459, that are applied for establishing a background for determining obviousness under 35 U.S.C. § 103 are summarized as follows:

1. Determining the scope and contents of the prior art;
2. Ascertaining the differences between the prior art and the claims at issue; and
3. Resolving the level of ordinary skill in the pertinent art.

3. Claims 21-24 are rejected under 35 U.S.C. § 103 as being unpatentable over Solazzi.

Solazzi, U.S. Pat. No. 4,409,854 illustrates in Fig. 2 a tubular member (18) defining an axial bore extending therethrough; and a receptacle member (17) defining

an interior cavity (41) for receiving a sample, the receptacle member having a tubular sidewall portion axially alignable with the tubular member and frictionally receivable within the axial bore and an endwall portion defining a centrally disposed reduced thickness region (38), wherein an upper edge (30) of the tubular sidewall portion is adapted to receive a flexible sheet of material (40) and wherein the receptacle member including an exterior annular collar (19) disposed proximate an end region of the tubular sidewall portion, whereby a sealed sample receptacle may be formed by placing said flexible sheet on the upper edge and inserting the tubular sidewall portion of the receptacle within the interior bore and whereby the reduced thickness region is piercable to permit atmospheric venting of the sealed sample receptacle. The endwall portion of the receptacle member defines an interior surface of the internal cavity and an exterior surface outside the internal cavity, the exterior surface defining a reservoir (60) for containing heat sensitive liquid samples. The tubular member including a circumferential extending bead (33) projecting from an interior surface thereof proximate a first end of the axial bore, and wherein an exterior surface of the tubular sidewall portion defines a circumferential extending recess (31) dimensioned and arranged to receive the bead of the tubular member when the annular collar surface of the receptacle member engages the circumferential edge of the tubular member. The circumferential edge being proximate a second end of the axial bore. However, Solazzi fails to disclose a surface of the annular collar engaging a circumferential edge of the tubular member

It would have been an obvious matter of design choice to modify the collar of Solazzi with a collar so that it would engage the circumferential edges of the tubular member, since such a modification would have involved a mere change in the size of the collar. A change in size is generally recognized as being within the level of

ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). In this case, a change in length of the collar of Solazzi, the structure being fabricated substantially of plastic would have been obvious to one of ordinary skill in the art, since plastic is recognized as a material which can be molded to any size, shape and length. The modified collar would have solved Applicant's overhang of extraneous film by increasing the length of the collar so that any edges may be covered by it, preventing from trimming any excess of flexible material. Such modification being considered to be obvious within the purview of one of ordinary skill in the art.

Response to Amendment

4. Applicant's arguments filed February 14, 1994 have been fully considered but they are not deemed to be persuasive.

Applicant contends the Examiner's use of impermissible hindsight, arguing that such use being gained from reading Applicant's disclosure. The Examiner being unable to show prior art suggesting Applicant's invention.

In response to Applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgement on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. *In re McLaughlin*, 443 F.2d 1392; 170 USPQ 209 (CCPA 1971).

With regard to applicant's argument regarding prior art lacking of showing or suggesting the instant invention notice that Solazzi ('854) on col. 3, lines 53-63 Solazzi states:

> " ...The snap ring **19** is the placed over the aperture of the cell and over the temporary collar held thin film and is pushed down until it locks in position by abutting against the edge **44** of the cell **17**. The interior ridge of the ring **19** in conjunction with the tapered neck **30** of the cell **17** firmly grasps film **40** during assembly to create and maintain a taut, wrinkle free sample plane as the ring **19** is pushed down. The peripheral groove **31** on the cell neck and the matching projection **33** of the collar **18** serve to retain the thin film sample plane in position after assembly.
>
> As explained above, in order to maintain equalization of pressure and to maintain a taut, thin film plane, the cell **17** includes the groove plunger **21** which is located as shown in Fig 2. on the bottom surface **60** of the closed bottom **35**."

Therefore, Solazzi ('854) provides sufficient suggestion and further motivation to one of ordinary skill in the art to arrive at the instant invention without the use of hindsight without knowledge gained from applicant's disclosure.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED

STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

vonReis et al., U.S. Pat. No. 4,362,047 disclose a filter covered for cigarette testing.

Eddleman et al., U.S. Pat. No. 4,301,010 disclose a vacuum filter.

Berger, Jr. et al., U.S. Pat. No. 4,256,474 disclose a filter housing and filter assemblies utilizing the same.

Vadnay et al., U.S. Pat. No. 4,184,360 a filter holder for cigarette research testing.

Burrow et al., U.S. Pat. No. 4,148,732 disclose a bacteria filter unit.

Freedlander, U.S. Pat. No. 2,127,397 discloses a strainer.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Milton I. Cano whose telephone number is (703) 308-3959.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Milton I. Cano: mic
April 27, 1994

James C. Housel
4/30/94
JAMES C. HOUSEL
SUPERVISORY PATENT EXAMINER
GROUP 180